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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,358	10/01/2003	Tsunemi Sugiyama	242578US0	7646

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

NOTE, JANIS L

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 08/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Notice of Non-Compliant
Amendment (37 CFR 1.121)**

Application No.

10/674,358

Examiner

Janis L. Dote

Applicant(s)

SUGIYAMA ET AL.

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1756

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

The amendment document filed on 08 June 2005 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121. In order for the amendment document to be compliant, correction of the following item(s) is required.

THE FOLLOWING MARKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

- ☒ 1. Amendments to the specification:
 - ☐ A. Amended paragraph(s) do not include markings.
 - ☐ B. New paragraph(s) should not be underlined.
 - ☒ C. Other see the attachment.
- ☐ 2. Abstract:
 - ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
 - ☐ B. Other _____.
- ☐ 3. Amendments to the drawings:
 - ☐ A. The drawings are not properly identified in the top margin as "Replacement Sheet," "New Sheet," or "Annotated Sheet" as required by 37 CFR 1.121(d).
 - ☐ B. The practice of submitting proposed drawing correction has been eliminated. Replacement drawings showing amended figures, without markings, in compliance with 37 CFR 1.84 are required.
 - ☐ C. Other _____.
- ☒ 4. Amendments to the claims:
 - ☐ A. A complete listing of all of the claims is not present.
 - ☐ B. The listing of claims does not include the text of all pending claims (including withdrawn claims)
 - ☒ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified. Note: the status of every claim must be indicated after its claim number by using one of the following status identifiers: (Original), (Currently amended), (Canceled), (Previously presented), (New), (Not entered), (Withdrawn) and (Withdrawn-currently amended).
 - ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
 - ☒ E. Other: see the attachment.

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP § 714 and the USPTO website at <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/officeflyer.pdf>.

TIME PERIODS FOR FILING A REPLY TO THIS NOTICE:

1. Applicant is given **no new time period** if the non-compliant amendment is an after-final amendment or an amendment filed after allowance. If applicant wishes to resubmit the non-compliant after-final amendment with corrections, the **entire corrected amendment** must be resubmitted within the time period set forth in the final Office action.
2. Applicant is given **one month**, or thirty (30) days, whichever is longer, from the mail date of this notice to supply the **corrected section** of the non-compliant amendment in compliance with 37 CFR 1.121, if the non-compliant amendment is one of the following: a preliminary amendment, a non-final amendment (including a submission for a request for continued examination (RCE) under 37 CFR 1.114), a supplemental amendment filed within a suspension period under 37 CFR 1.103(a) or (c), and an amendment filed in response to a *Quayle* action.

Extensions of time are available under 37 CFR 1.136(a) only if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action.

Failure to timely respond to this notice will result in:

Abandonment of the application if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action; or

Non-entry of the amendment if the non-compliant amendment is a preliminary amendment or supplemental amendment.

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Attachment: Notice of NON-COMPLIANT AMENDMENT (37 CFR 1.121)

Only the corrected sections of the non-compliant amendment document must be resubmitted (in its entirety), in this case, the entire "Amendment to the specification" section and the entire "Amendment to the claims" section of applicants' amendment document filed on Jun. 8, 2005, must be resubmitted. 37 CFR 1.121(h).

The "Amendment to the specification" section filed on Jun. 8, 2005, does not comply with 37 CFR 1.121 for the following reasons:

Item C: The amended paragraphs beginning at page 46, line 26, page 49, line 11, page 49, line 25, page 50, line 12, page 50, line 26, and page 51, line 14, of the specification, replaced the word "provide" in the previously disclosed phrase "pulverized by a pulverizer to provide a . . . master batch . . ." (emphasis added) with the word -- prepare -- without using the proper markings to indicate deleted text and to indicate added text. Applicants have improperly amended the paragraphs.

37 CFR 1.121(b)(1)(ii) states that "[t]he full text of any replacement paragraph with markings to show all the changes relative to the previous version of the paragraph. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the

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deleted characters may be used to show deletion of five or fewer consecutive characters . . ." (emphasis added).

The "Amendment to the claims" section filed on Jun. 8, 2005, does not comply with 37 CFR 1.121 for the following reasons:

Item E: The amendment to claim 1, labeled "currently amended," does not comply with 37 CFR 1.121 because applicants have rewritten the previously recited phrases "dispersing a toner composition," "resin capable of forming the urea-modified polyester," ", thereby forming a liquid," and "to provide particles" (emphasis added) in originally filed claim 1 to read -- dispersing toner compositions --, -- resin capable of being the urea-modified polyester --, -- to prepare a liquid --, and -- to prepare particles - (emphasis added), respectively, without using the proper markings to indicate deleted text and to indicate added text. Applicants have improperly amended claim 1.

Items C and E: (1) Claim 2 is improperly labeled as "original." Claim 2 should be labeled as "currently amended." Applicants rewrote the phrase "the pigment dispersant is present in an amount of 1 to 30% by weight" (emphasis added) in originally filed claim 2 to read -- a content of the pigment dispersant is 1 to 30 wt% -- (emphasis added), without using the

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proper markings to indicate deleted text and to indicate added text. Applicants have improperly labeled and amended claim 2.

(2) Claim 4 is improperly labeled as "original." Claim 4 should be labeled as "currently amended." Applicants deleted the word "of" in the phrase "particle diameter of not greater than 0.5 μm " (emphasis added) in originally filed claim 4 without using the proper markings. Applicants have thus improperly labeled and amended claim 4.

(3) Claim 5 is improperly labeled as "original." Claim 5 should be labeled as "currently amended." Applicants rewrote the phrases "toner composition" and "a weight ratio (i/ii) of the urea-modified polyester resin (i) to the unmodified polyester resin (ii)" (emphasis added) in the originally filed claim 5 to read -- toner compositions -- and -- a weight ratio (i/ii) between the modified polyester resin (i) and unmodified polyester resin (ii) -- (emphasis added), respectively, without using the proper markings to indicate deleted text and to indicate added text. Applicants have improperly labeled and amended claim 5.

(4) Claim 8 is improperly labeled as "original." Claim 8 should be labeled as "currently amended." Applicants rewrote the phrase "(Dv/Dn) of the volume-average particle diameter (Dv) to the number-average particle diameter (Dn)" (emphasis added)

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in the originally filed claim 8 to read -- (Dv/Dn) between the volume-average particle diameter (Dv) and a number-average particle diameter (Dn) -- (emphasis added), without using the proper markings to indicate deleted text and to indicate added text. Applicants have improperly labeled and amended claim 8.

37 CFR 1.121 reads: "[W]hen claim text with markings is required. All claims being currently amended . . . shall . . . be submitted with markings to indicate changes that have been made relative to the immediate prior version of the claims. The text of any added subject must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets [i.e., [[]] placed before and after the deleted characters may be used to show deletion of five or fewer consecutive letters" (emphasis added).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janis L. Dote whose telephone number is (571) 272-1382. The examiner can normally be reached Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Mark Huff, can be reached on (571) 272-1385. The central fax phone number is (571) 203-8300.

Any inquiry regarding papers not received regarding this communication or earlier communications should be directed to Supervisory Application Examiner Ms. Claudia Sullivan, whose telephone number is (571) 272-1052.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Janis L. Dote
JANIS L. DOTE
PRIMARY EXAMINER
GROUP 1500
F700

JLD

Aug. 11, 2005